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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,564	01/28/2004	Sheridan E. Vincent	80686CJLT	5092
7590 01/21/2005			EXAMINER	
Paul A. Leipold Eastman Kodak Company 343 State Street Rochester, NY 14650-2201			LE, HOA VAN	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 01/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/767,564

Applicant(s)

VINCENT ET AL.

Examiner

Hoa V. Le

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-- The MAILING DATE of this communication appears *n th* cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 30 and 37-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 30 and 37-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>28 January 2004</u> . | 6) <input type="checkbox"/> Other: _____  |

This is in response to Papers filed on 22 November 2004.

I. Applicants elect the invention of Group IV, claims 30 and 37-47, with traverse being acknowledged. Since applicants could not be able to provide a reasonable issue for their traversal, it would be proper to treat the election without traverse.

II. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 42 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the use thiosulfate as a fixing agent to dissolve silver halide matter, does not reasonably provide enablement for sole fixing agent. The inventive claims are proper or commensurate in scope with the general knowledge in the photographic art. The record shows that applicants fail to comprehend that (1) a mercaptotriazole containing compound or (2) a sulfite containing compound is known and used as a fixing agent to dissolve silver halide matter. Evidence can be seen at least in (1) Kojima et al (5,338,648) at compounds 13, 14, 15, 16, 17, 33 and 48 as that of thiosulfate containing compound. Please also see the results, demonstrations and reductions to practice in Examples or (2) Fyson et al (5,876,906) at col.1:61-63. Its results, demonstrations and reductions to practice in Examples.

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III. For the same reason as clearly pointed out in paragraph "II" above, the embodiments in the specification with respect to a bleach-fixing composition comprising a thiosulfate containing compound as the sole fixing agent and a mercaptotriazole containing compound or with sulfite containing compound is objected to under 35 USC 112, first paragraph.

No allowance will be indicated for (1) the specification or (2) claims until a proper and complete correction is made and overcome.

IV. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 30 and 37-47 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,582,893 in view of Kadota et al (4,748,105).

The applied claims 1-15 are related to a bleach-fixing composition having a pH of 4 to 8 and comprising from 0.05 mol/l of a Fe<sup>++</sup> containing bleaching agent, from 0.15 mol/l of a thiosulfate containing compound and a sulfite containing compound.

The applied claims do not cite a mercaptotriazole containing compound as an additional fixing agent or a bleach accelerating agent. It is known in the art to cite and use a

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mercaptotriazole containing compound as bleach accelerating agent in a bleach-fixing composition to speed up a desilvering process. Evidence can be seen in Kadota et al at col.96:13-16 and compound V(75-100) at cols.123-126.

Since the above references are all related to desilvering an exposed and color developed image, it would have been obvious to one having ordinary skill in the art at the time the invention was made to cite the known use of mercaptotriazole containing compound as an additional fixing agent and bleach accelerating agent from Kadota et al for a reasonable expectation of obtaining a rapid desilvering process.

V. The prior art with respect to (2) those being already considered in the parent application are reasonably considered as typographical error from Fe+++ to Fe++ as pointed out and set forth the record in the parent application except for DE 100 13 614 with application filing date on 18 March 2000 and publication date on 25 October 2001, patented on 15 January 2004. No US application has been found. Inventor names have been searched and (2) those as newly added are also reasonably considered and typographical error from Fe+++ to Fe ++ since they are all had and based on the foreign priority documents.

VI. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 30 and 37-47 are provisionally rejected under 35 U.S.C. 102(b) as being anticipated by Takabayashi et al (JP 63-95451 specification, Abstracts and an oral translator in the Office) until an English language translation is obtained and applied. An English language translation is ordered and will be provided before an appeal brief is filed).

Takabayashi et al disclose and teach a bleach-fixing composition having a pH of from 3.0-6.8 comprising a conventional amount of a iron (II) containing bleaching agent (Abstracts), a conventional amount of a thiosulfate containing fixing agent (translator), a sulfite containing compound (translator) and a conventional amount mercaptotriazole containing compound A-2 (specification, on page 7, top, left column), ammonium salt (translator). Since Takabayashi et al is reasonably disclose and teach the requisite chemical ingredients and their amounts in the claims, they are reasonably anticipated by Takabayashi et al.

VII. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 30 and 37-47 are provisionally rejected under 35 U.S.C. 103(a) as being unpatentable over Takabayashi et al ((JP 63-95451 specification, Abstracts and an oral translator in the Office) until an English language translation is obtained and applied. An English language translation is ordered and will be provided before an appeal brief is filed) alone or considered in view of Kadota et al (4,748,105) and Inaba et al (5,885,757).

Takabayashi et al disclose, teach and suggest a bleach-fixing composition having a pH of from 3.0-6.8 comprising a conventional amount of a iron (II) containing bleaching agent (Abstracts), a conventional amount of a thiosulfate containing fixing agent (translator), a sulfite containing compound (translator) and a conventional amount mercaptotriazole containing compound A-2 (specification, on page 7, top, left column), ammonium salt (translator).

The abstracts fail to cite an amount and an aminopolycarboxylic acid containing bleaching agent, an amount and thiosulfate containing fixing agent, a mercaptotriazole as an additional fixing or bleach accelerating agent and an amount of ammonium ions. Please see Kadota et al at col.96:13-16, and compound V(75-100) at cols.123-126, col.138:55-59, col.140, compounds 1, 3, 5, 7, 9, 11, 13, 16, 17, 19, 21, 23, 25, 27-29, col.141:22-30, 60 to col.142:3, 14 and col.157:56-58 for the known additive benefits.

The abstracts fail to cite an amount and carboxylic acid buffering agent as conventional additive in a bleach-fixing composition. Please Inaba et al at col.18:30-59 for the known buffering benefit. The use ammonium ions in a bleach-fixing composition would provide a rapid fixing property at col. 20:15-16

Since the above references are all related to desilvering an exposed and color developed image, it would have been obvious to one having ordinary skill in the art at the time the invention was made to cite the known use of the conventional additive agent from Kadota et al and Inaba et al for a reasonable expectation of obtaining a rapid desilvering process with stable bleach-fixing composition.

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VIII. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 30 and 37-47 are provisionally rejected under 35 U.S.C. 102(b) as being anticipated by Kuse et al (JP 63-95452 specification, Abstracts and an oral translator in the Office) until an English language translation is obtained and applied. An English language translation is ordered and will be provided before an appeal brief is filed).

Kuse et al disclose and teach a bleach-fixing composition having a pH of from 3.0-6.8 comprising a conventional amount of a iron (II) containing bleaching agent (Abstracts), a conventional amount of a thiosulfate containing fixing agent (translator), a sulfite containing compound (translator) and a conventional amount mercaptotriazole containing compound A-2 (specification, on page 7, top, left column), ammonium salt (translator). Since Kuse et al is reasonably disclose and teach the requisite chemical ingredients and their amounts in the claims, they are reasonably anticipated by Kuse et al.

IX. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 30 and 37-47 are provisionally rejected under 35 U.S.C. 102, 103(a) or both of them as being anticipated or unpatentable over Kuse et al ((JP 63-95452 specification, Abstracts



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and an oral translator in the Office) until an English language translation is obtained and applied.

An English language translation is ordered and will be provided before an appeal brief is filed alone or considered in view of Kadota et al (4,748,105) and Inaba et al (5,885,757).

Kuse et al disclose, teach and suggest a bleach-fixing composition having a pH of from 3.0-6.8 comprising a conventional amount of a iron (II) containing bleaching agent (Abstracts), a conventional amount of a thiosulfate containing fixing agent (translator), a sulfite containing compound (translator) and a conventional amount mercaptotriazole containing compound A-2 (specification, on page 7, top, left column), ammonium salt (translator).

The abstracts fail to cite an amount and an aminopolycarboxylic acid containing bleaching agent, an amount and thiosulfate containing fixing agent, a mercaptotriazole as an additional fixing or bleach accelerating agent and an amount of ammonium ions. Please see Kadota et al at col.96:13-16, and compound V(75-100) at cols.123-126, col.138:55-59, col.140, compounds 1, 3, 5, 7, 9, 11, 13, 16, 17, 19, 21, 23, 25, 27-29, col.141:22-30, 60 to col.142:3, 14 and col.157:56-58 for the known additive benefits.

The abstracts fail to cite an amount and carboxylic acid buffering agent as conventional additive in a bleach-fixing composition. Please Inaba et al at col.18:30-59 for the known buffering benefit. The use ammonium ions in a bleach-fixing composition would provide a rapid fixing property at col. 20:15-16

Since the above references are all related to desilvering an exposed and color developed image, it would have been obvious to one having ordinary skill in the art at the time the invention was made to cite the known use of the conventional additive agent from Kadota et al

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and Inaba et al for a reasonable expectation of obtaining a rapid desilvering process with stable bleach-fixing composition.

X. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le  
Primary Examiner  
Art Unit 1752

HVL  
19 January 2005

HOA VAN LE  
PRIMARY EXAMINER

*Hoa Van Le*